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10/775,075	02/11/2004	Kensaku Shinozaki	042100	3422

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EXAMINER

VAN, LUAN V

ART UNIT PAPER NUMBER

1753

DATE MAILED: 11/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/775,075

Applicant(s)

SHINOZAKI, KENSAKU

Examiner

Luan V. Van

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/15/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 15, 2006 has been entered.

### ***Response to Amendment***

Applicant's amendment of August 15, 2006 does not render the application allowable.

The amendment is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claims 1-6 and 10-11 are amended to recite the limitation of "wherein knob-like projections are formed intermittently on its smooth matte side" However, there is no evidence in the applicant's disclosure to support the amended limitation. The specification clearly does not teach that the knob-like projections are formed intermittently. The examiner acknowledges that the projections may be intermittent on the surface of the copper foil. However, the

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specification does not support that the projections are formed intermittently. This can be broadly interpreted as forming one projection at a time, and thus would be a process limitation. The disclosure, therefore, does not provide a clear indication to support the amended limitation. Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Status of Objections and Rejections***

All are rejections from the previous office action are maintained.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 and 10-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-6 and 10-11 are amended to recite the limitation of "wherein knob-like projections are formed intermittently on its smooth matte side" However, there is no evidence in the applicant's disclosure to support the amended limitation. The

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specification clearly does not teach that the knob-like projections are formed intermittently. The examiner acknowledges that the projections may be intermittent on the surface of the copper foil. However, the specification does not support that the projections are formed intermittently. This can be broadly interpreted as forming one projection at a time. The disclosure, therefore, does not provide a clear indication to support the amended limitation.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6 and 10-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fatcheric et al.

Regarding claim 1, Fatcheric et al. teach an electrodeposited copper foil wherein part of its surface comprises a surface having knob-like projections (figure 2) and a surface roughness of 4-7.5 micrometer (on the matte side, column 3 lines 33-35), which is within the range of the instant claim. With respect to the limitation of the projections being formed intermittently, such limitation is not given patentability weight, because the instant claim is directed to a product. Nevertheless, the knob-like projections of Fatcheric et al. as seen in Fig. 2 are broadly interpreted to be intermittent.

In addition, the limitation "wherein the copper foil is an untreated copper foil" is a process limitation, and thus is not given patentability weight, since the copper foil is distinguished by the surface roughness characteristic and not by whether it has been treated or untreated. However, even assuming that an untreated copper foil is given weight, Fatcheric et al. anticipate the instant claim, since the roughness is within the range of the instant claim before the treatment (column 3 lines 33-35).

According to MPEP 2113, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a

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different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Furthermore, it would have been obvious to one having ordinary skill in the art to have recognized that the knob-like projections of Fatcheric et al. are intermittent, because the projections are not continuous.

Regarding claim 2, Fatcheric et al. teach an electrodeposited copper foil wherein said rough surface having said knob-like projections and said surface roughness of 4-7.5 micrometer is a surface of an untreated copper foil for bonding with a resin substrate and is further roughening treated by running a predetermined current (column 5 lines 7-10) through the foil for a predetermined time (column 5 lines 7-10) in an electroforming bath.

Regarding claim 3, Fatcheric et al. teach an electrodeposited copper foil, wherein said electroforming bath is an acidic electroforming bath containing arsenic (column 5 lines 7-17).

Regarding claim 4, Fatcheric et al. teach an electrodeposited copper foil wherein said rough surface is further formed with a copper plating layer (column 5 lines 7-17).

Regarding claim 5-6 and 10-11, Fatcheric et al. teach an electrodeposited copper foil wherein said rough surface is further formed with a copper plating layer and at least one layer of nickel plating, zinc plating, cobalt plating, plating of an alloy of the same (column 5 lines 13-20) and a chromate treatment layer (column 5 lines 21-23) on that, or further formed with a coupling agent treatment layer (column 5 lines 21-24) .

Claims 1-2 and 4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wolski et al. '140.

Regarding claim 1, Wolski et al. '140 teach an electrodeposited copper foil wherein part of its surface comprises a rough surface having knob-like projections (or nodules, column 3 lines 18-22) and a surface roughness of 3.3 to 3.7 micrometer (on the matte side, see comparative example 1 in table 2 and table 3), which is within the range of the instant claim. With respect to the limitation of the projections being formed intermittently, such limitation is not given patentability weight, because the instant claim is directed to a product. In addition, the limitation "wherein the copper foil is an untreated copper foil" is a process limitation, and thus is not given patentability weight, since the copper foil is distinguished by the surface roughness characteristic and not by whether it has been treated or untreated.

As described above, according to MPEP 2113, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

In addition, it would have been obvious to one having ordinary skill in the art to have recognized that the projections of Wolski et al. '140 are intermittent, because the



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foil is made by the same method, i.e. electrodepositing (see Abstract), and has the same roughness as that of the instant claim.

Regarding claim 2, Wolski et al. '140 teach an electrodeposited copper foil wherein part of its surface comprises a rough surface having knob-like projections (or nodules, column 3 lines 18-22) and a surface roughness of 3.3 to 3.7 micrometer (on the matte side, see comparative example 1 in table 2 and table 3) is a surface of an untreated copper foil for bonding with a resin substrate and is further roughening treated by running a predetermined current (table 1) through the foil for a predetermined time in an electroforming bath. The electrolysis is inherently performed for a predetermined time.

Regarding claim 4, Wolski et al. '140 teach an electrodeposited copper foil wherein said rough surface is further formed with a copper plating layer (column 5 lines 30-35).

### ***Claim Rejections - 35 USC § 103***

Claims 3, 5, 6 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolski et al. '140 in view of Fatcheric et al.

Wolski et al. '140 teach the copper foil as described above. The difference between the reference to Wolski et al. '140 and the instant claims is that the reference does not explicitly teach forming an additional nickel, zinc, cobalt layer or alloy thereof and a chromate layer.

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Fatcheric et al. teach an electrodeposited copper foil, wherein said electroforming bath is an acidic electroforming bath containing nickel, cobalt, zinc or arsenic for depositing the respective metal or alloys thereof (column 5 lines 7-17). Additionally, Fatcheric et al. teach an electrodeposited copper foil wherein said rough surface is further formed with a copper plating layer and at least one layer of nickel plating, zinc plating, cobalt plating, plating of an alloy of the same (column 5 lines 13-20) and a chromate treatment layer (column 5 lines 21-23) on that, or further formed with a coupling agent treatment layer (column 5 lines 21-24).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the foil of Wolski et al. '140 by depositing a zinc layer of Fatcheric et al., because the zinc layer provides a barrier layer between the copper foil and the laminating resin substrate in order to prevent laminate staining which occurs when ingredients of the resin chemically react with copper (column 4 lines 50-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have further modified the foil of Wolski et al. '140 by depositing a chromate layer of Fatcheric et al., because it would provide a protective layer for the underlying barrier layers (column 5 lines 21-22).

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive.

In the arguments presented on page 6 of the amendment, the applicant argues that the knob-like projections are formed intermittently on the surface of the copper foil,

specifically pointing to Fig. 3 of the instant specification as support. The examiner acknowledges that the knob-like projections may be intermittently spaced on the surface of the copper foil; however, the examiner does not agree that Fig. 3 supports the limitation as currently phrased that the knob-like projections are formed intermittently on the surface. This can be broadly interpreted as forming one projection at a time, and thus would be a process limitation. Therefore, this argument is deemed to be unpersuasive, and therefore the rejection under 35 USC 112 is maintained.

The examiner takes the position that the knob-like projections of Fatcheric et al. as seen in Fig. 2 are broadly interpreted to be intermittent, because the knob-like projections are not continuous since the projections are spaced between the valleys on the surface of the copper foil.

The applicant also argues that Fatcheric et al. do not teach forming a copper plating layer on the surface in page 11. The examiner respectfully disagrees. Fatcheric et al. teach this step in column 4 lines 49-64.

Similarly, the applicant argues in page 12 that Wolski et al. '140 do not teach knob-like projections are formed intermittently. As described above with respect to the limitation of the projections being formed intermittently, such limitation is not given patentability weight, because the instant claim is directed to a product. In addition, the limitation "wherein the copper foil is an untreated copper foil" is a process limitation, and thus is not given patentability weight, since the copper foil is distinguished by the surface roughness characteristic and not by how it is treated or untreated. According to MPEP 2113, even though product-by-process claims are limited by and defined by the

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process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

### **Conclusion**

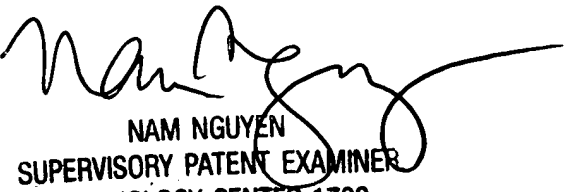
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan V. Van whose telephone number is 571-272-8521. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LWV

11/1/06

  
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